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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,345	12/10/2001	Christopher J. Stone	GIC-656	6495

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GENERAL INSTRUMENT CORPORATION DBA THE CONNECTED
HOME SOLUTIONS BUSINESS OF MOTOROLA, INC.
101 TOURNAMENT DRIVE
HORSHAM, PA 19044

EXAMINER	
SHEPARD, JUSTIN E	
ART UNIT	**PAPER NUMBER**
2623	
MAIL DATE	**DELIVERY MODE**
07/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/016,345	STONE, CHRISTOPHER J.	
	Examiner	Art Unit	
	Justin E. Shepard	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 6-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 6-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/13/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/13/07 have been fully considered but they are not persuasive.

Page 7, last paragraph and page 8, first paragraph:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the details of the channel map given in the arguments) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Specifically, the applicant shows why their "channel map" differs from what the examiner has cited to meet this limitation. In reviewing Hidary, the reference shows that data indicating what frequency the desired channel resides at is sent to the television. The examiner admits that this would not be considered a complete channel map, mapping all of the channels to their particular frequencies; it does meet the limitation for a single channel.

Page 9, last paragraph:

The applicant argues that a TV window is used to show the program, and not a separate TV. In column 8, lines 46-47 (and figure 4, parts 16 and 114) show that the computer and TV can be separate and therefore meet the limitation.

Page 11, first paragraph:

The applicant argues that the combination of Hidary and Bendinelli is not valid. As Hidary can perform the same action as Bendinelli (but just in a slightly different fashion, which is what Bendinelli is being used to teach) (Hidary: column 8, lines 54-57), the examiner feels that this combination is valid.

Page 11, second paragraph:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the reduction in developmental costs is a valid reason to combine as new technologies require development (which incurs costs) and it is in the company's best interest to keep the cost down.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7, 10-14, 17, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hidary.

Referring to claim 1, Hidary discloses a method for tuning a television appliance having a first screen for displaying data (figure 4, part 114) using an internet appliance having a second screen for displaying data (figure 4, part 16; column 8, lines 46-49), comprising:

providing a program advertisement to said Internet appliance (column 8, lines 64-67; column 9, lines 1-2);

providing channel map information to said Internet appliance which identifies a channel for a program advertised in said program advertisement (column 8, lines 61-64);

displaying said program advertisement on said second screen on said Internet appliance (column 8, lines 46-49);

selecting said advertised program via interaction with said program advertisement (column 8, lines 64-67; column 9, lines 1-2);

communicating a tune command to said television appliance from said Internet appliance (column 8, lines 64-67; column 9, lines 1-2);

tuning said television appliance to said channel in response to said tune command (column 8, lines 64-67; column 9, lines 1-2); and

performing a first action in response to tuning to said channel (column 8, lines 46-49).

Referring to claim 2, Hidary discloses a method in accordance with claim 1, further comprising: creating said tune command for said advertised program based on said channel map information (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 3, Hidary discloses a method in accordance with claim 1, wherein said television appliance comprises one of a television (column 8, lines 46-49), a digital video recorder, a videocassette recorder, a personal versatile recorder, or a set-top terminal.

Referring to claim 7, Hidary discloses a method in accordance with claim 1, wherein: said program advertisement is provided to the Internet appliance via an external communication network (column 8, lines 19-24); and said channel map information is provided to the Internet appliance by a system operator (column 5, lines 53-55).

Referring to claim 10, Hidary discloses a method in accordance with claim 1, wherein said advertisement comprises a hypertext markup language (HTML) link (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 11, Hidary discloses a method in accordance with claim 10, wherein said HTML link includes a channel identifier from said channel map corresponding to the program identified in said advertisement (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 12, Hidary discloses a method in accordance with claim 11, wherein said tune command comprises said channel identifier (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 13, Hidary discloses a method in accordance with claim 1, wherein said advertisement is provided to said internet appliance via the use of an internet protocol datagram (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 14, Hidary discloses a method in accordance with claim 1, wherein said datagram is constructed using hypertext transfer protocol (HTTP) (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 17, Hidary discloses a method in accordance with claim 1, wherein the first action is displaying interactive web pages on said second screen on said internet appliance which relate to said advertised program (column 8, lines 64-67; column 9, lines 1-2).

Referring to claim 21, Hidary discloses a method in accordance with claim 1, wherein said Internet appliance comprises one of a wireless web pad, a personal computer (column 8, lines 46-49), or a web-enabled personal digital assistant.

Referring to claim 22, Hidary discloses a method in accordance with claim 1, wherein the program advertisement comprises a targeted advertisement directed to one of a specific viewer or group of viewers (column 6, lines 53-58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Bendinelli.

Referring to claim 6, Hidary does not disclose a method in accordance with claim 1, wherein the channel map information is provided from the television appliance to the Internet appliance.

Bendinelli discloses a method in accordance with claim 1, wherein the channel map information is provided from the television appliance to the Internet appliance (figure 4, parts 102, 106, and 110).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add delivering the URL to the computer from the STB as taught by Bendinelli to the method disclosed by Hidary. The motivation would have been to lower the processing power required by the computer by only passing the URL, and not the television signal, to the computer.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Nguyen.

Referring to claim 8, Hidary does not disclose a method in accordance with claim 1, wherein said television appliance either (i) includes a cable modem, or (ii) is associated with a cable modem.

Nguyen discloses a method in accordance with claim 1, wherein said television appliance either (i) includes a cable modem, or (ii) is associated with a cable modem (paragraph 26, lines 3-12; paragraph 46, lines 12-14).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the cable modem taught by Nguyen to the method disclosed by Hidary. The motivation would have been to enable the user to browse the Internet on the television, as well as the computer.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Nguyen as applied to claim 8 above, and further in view of Ekkel.

Referring to claim 9, Hidary discloses a method in accordance with claim 8, wherein said selected program channel map information is communicated from the Internet appliance to the television appliance (column 8, lines 64-67; column 9, lines 1-2).

Hidary and Nguyen do not disclose a method wherein the communication is performed via the cable modem.

Ekkel discloses a method wherein the communication is performed via the cable modem (paragraph 7).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the cable modem communication taught by Ekkel to the method disclosed by Hidary and Nguyen. The motivation would have been to enable the use of a common protocol that is well known in the art to cut down on developmental costs.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary.

Referring to claim 15, Hidary does not disclose a method in accordance with claim 1, wherein said advertisement appears on said second screen on said internet appliance as a pop-up advertisement.

The examiner takes Official Notice that it would have been notoriously well known in the art to use a pop-up advertisement to display a website.

At the time of the invention it would have been obvious for one of ordinary skill in the art to use a pop-up advertisement to display the web information disclosed in

Hidary. The motivation would have been that a pop-up advertisement has more visibility than a single link in a webpage and would more likely be noticed by a user.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Reichardt.

Referring to claim 16, Hidary does not disclose a method in accordance with claim 1, wherein said advertisement is targeted for display on a specific location on the second screen on the Internet appliance.

Reichardt discloses a method in accordance with claim 1, wherein said advertisement is targeted for display on a specific location on the second screen on the Internet appliance (paragraph 93, lines 4-13; figure 9a, box 108).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the positioned advertisement taught by Reinhardt to the method disclosed by Hidary. The motivation would have been to enable the ad to be placed in a familiar place that the user would know to look for, making the ad more visible.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Lortz.

Referring to claim 18, Hidary does not disclose a method in accordance with claim 1, wherein the action is setting a recording device to record said advertised program.

Lortz discloses a method in accordance with claim 1, wherein the action is setting a recording device to record said advertised program (column 5, lines 41-42, 48-50, and 57-62).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the video recording taught by Lortz to the system disclosed by Hidary. The motivation would have been to enable the STB to record the television program when the user was reading an article on the linked website, therefore stopping the user from missing the program.

Referring to claim 19, Hidary does not disclose a method in accordance with claim 18, wherein said recording device is one of a digital video recorder associated with said television appliance, a personal versatile recorder system integrated into said television appliance, or a video cassette recorder.

Lortz discloses a method in accordance with claim 18, wherein said recording device is one of a digital video recorder associated with said television appliance, a personal versatile recorder system integrated into said television appliance (figure 3, part 20), or a video cassette recorder.

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the video recording taught by Lortz to the system disclosed by Hidary. The motivation would have been to enable the STB to record the television program when the user was reading an article on the linked website, therefore stopping the user from missing the program.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary in view of Ekkel.

Referring to claim 20, Hidary does not disclose a method in accordance with claim 1, where said television appliance and said internet appliance communicate via one of (i) an infrared link, or (ii) an RF link.

Ekkel discloses a method in accordance with claim 1, where said television appliance and said internet appliance communicate via one of (i) an infrared link, or (ii) an RF link (paragraph 7).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the RF communication taught by Ekkel to the method disclosed by Hidary and Nguyen. The motivation would have been to enable the use of a common protocol that is well known in the art to cut down on developmental costs.

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